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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,623	06/18/2001	Pavitra Subramaniam	5306P016	4377
8791	7590	09/03/2004	EXAMINER	
BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD SEVENTH FLOOR LOS ANGELES, CA 90025-1030			ALAUBAIDI, HAYTHIM J	
			ART UNIT	PAPER NUMBER
			2171	

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/883,623	Applicant(s) SUBRAMANIAM ET AL.	
	Examiner Haythim J. Alaubaidi	Art Unit 2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to the amendment filed on June 7, 2004.
2. Claims 1-31 are presented for examination following the amendment of June 7, 2004.
3. Independent Claims 1, 10, 16, 21 and 27 still stand rejected based on the double patenting rejection noted in the April 9, 2004 Office Action.
4. Claims 1-31, are rejected under 35 U.S.C. 103(a).
5. Claims 1, 10, 16 and 21 are rejected under 35 U.S.C. 101.

Response to Amendment

6. The Applicant stated in the Amendment of June 7, 2004 that a terminal disclaimer was filed with the amendment to overcome the double patenting, yet the Examiner received **no** such disclaimer. The double patenting rejection still stands in this office action.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 10, 16 and 21, are rejected under 35 U.S.C. 101 because the claimed invention stated in the claims is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological art. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological art fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In *Bowman* (Ex parte *Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished), the board affirmed the rejection under U.S.C. 101 as being directed to non-statutory subject matter. Although *Bowman* discloses transforming physical media into a chart and physically plotting a point on said chart, the Board held that the claimed invention is nothing more than an abstract idea, which is not tied to any technological art or environment.

In the present case, claims 1, 10, 16 and 21 all recites an abstract idea at the preamble; in addition, the steps in the claim body merely applying a search and generating results, which can be implemented by the mind of a person or by the use of a pencil and paper. In another words, since the claimed invention, as a whole, is not within the technological arts as explained above, these claims only constitute an idea and does not apply, involve, use, or advance the technological arts, thus, it is deems to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-31, are rejected under 35 U.S.C. 103(a) as being unpatentable by Michael Edward Moran (U.S. Patent No. 6,014,662 and Moran hereinafter) in view of John M. Kessenich (U.S. Patent No. 6,292,802 and Kessenich hereinafter).

Regarding Claims 1, 10, 16 and 27, Moran discloses:

receiving search criteria entered by a user (Col 2, Lines 19-20; see also Col 5, Lines 8-14; see also Col 6, Lines 11-13, i.e. the system awaits 1302 the choosing of a category by the user)

searching a database for data record matching the search criteria (Col 5, Lines 41-45; see also Col 5, Lines 50-51; see also Col 6, Lines 13-14, i.e. a search is performed for the category)

generating search results (Col 6, Line 14-15, i.e. and the category is displayed 1304 in the book format; see also Col 3, Lines 56-59)

Moran reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate the keyword searching nor does it explicitly indicate the caching feature. However Kessenich discloses keyword searching (Figure 5, Element 416 and corresponding text) and caching the search result (Col 18, Lines 34-59). Given the intended broad application of Moran's system, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Moran with the teachings of Kessenich to include keyword searching as it is the most popular and the most well known search for database mining, caching the results would almost be inherent¹. The motivation would be to have a well-functioning mining system and to increase the flexibility of the system by adding other search methods (keyword searching) and to increase the system performance, by

¹ The Examiner would like to explain that almost any search on a database that return results would be cached inherently in the memory, as it is known to be displayed on a terminal of the user and it should stay displayed because it was cached in memory when the results were received. This is also include the feature of terminating the session. If the user keeps displaying the results on screen or even if he/she modified the screen (minimized the view, or further refined the search) the result (that were cached in memory) will still be available to the user, and will not be lost, unless the user terminate the session, like for example, close the window. Example, searching for a keyword on any search engine on the Internet and further refining the results, also the user can click the "Back" button to go back to prior results and they should be still available as it was cached in memory.

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searching (refining) the search results that were cached in memory instead of running another search.

Regarding Claims 2, 17 and 22, Moran discloses receiving search category (Col 6, Lines 57-61).

Regarding Claims 3, 18, 23 and 31, Kessenich discloses refining search results (Col 13, Lines 29-33).

Regarding Claim 4, Moran discloses passing the received search criteria to a virtual business component (Col 3, Lines 11-27; see also Col 6, Lines 24-30)².

Regarding Claim 5, Moran discloses passing the received search criteria from the virtual business component to a search execution business service³, (Col 2, Lines 54-55), i.e.

FIG. 12 is a block diagram of a search engine in accordance with the present invention.

Regarding Claims 6 and 13, the limitations of these claims have been noted in the rejected claim No. 1, above. In addition Moran discloses using a search execution business service to search the database (Col 3, Lines 11-27).

² The Examiner would like to bring the Applicant's attention to the reason why the citation of Col 3, Lines 11-27 were cited and it's connection to the meaning of the "Virtual Business Component", the Examiner is basing this reason to what is in the Specification of the instant application (please see Page 41, Lines 6-14, i.e. external data).

Regarding claims 7 and 14, the limitations of these claims are similar in scope to the rejected claim 1, above. They are therefore rejected as set forth above.

Regarding Claims 8, 19, 25 and 29 Moran discloses caching the search result until termination of a user session (Col 6, Lines 17-23) [see also footnote No. 1], i.e.

The user can select a new category 1307 if the first selection was inappropriate, or has exhausted resources of a selected category 1309. Closing 1310 of the book to end 1311 the display or to select another book 1312 is a choice the user can make at any time during the process. Once a book has been closed, another book can be selected.

Regarding claims 9, 15, 20, 26 and 30, the limitations of this claim is similar in scope to the rejected claim 1, above. They are therefore rejected as set forth above.

Regarding claim 11, the limitations of this claim are similar in scope to the rejected claims 2 and 4, above. It is therefore rejected as set forth above.

Regarding claim 12, the limitations of this claim are similar in scope to the rejected claims 3 and 5, above. It is therefore rejected as set forth above.

Regarding claim 21, the limitations of this claim are similar in scope to the rejected claims 1 and 4, above. It is therefore rejected as set forth above.

³ Please note that the Examiner is interpreting the "search execution business service" as a Search Engine.

Regarding claim 24, the limitations of this claim are similar in scope to the rejected claims 1 and 7, above. It is therefore rejected as set forth above.

Regarding claim 28, the limitations of this claim are similar in scope to the rejected claims 2 and 3, above. It is therefore rejected as set forth above.

Response to Arguments

10. Applicant's arguments, filed June 7, 2004, with respect to the rejection(s) of claim(s) 1-31, have been fully considered, but they are not persuasive.

a. Applicant argues that combining Moran's reference with Kessenich would not have been obvious. The Examiner however disagrees. Moran's teaches wherein a user is entering signals (which the examiner is interpreting it to be as search categories or criteria) through a keyboard to a search system (Col 5, Lines 8-15); Moran also teach the feature of receiving search criteria, such as in selecting a book or in selecting a category in the book (Col 6, Lines 9-17).

As far as for combining the two references; the Examiner would like to present two arguments:

1- would be the general knowledge; as the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the general knowledge available to an ordinary skilled in the art is the use of keywords in the search which can be found throughout Kessenich's reference, example Figures 5-7, Element 416 and corresponding text.

2- would be the motivation; as Moran discloses keyword search capabilities in Figure 8, right side window under the large bold IBM logo. The Examiner understand that this feature is a keyword search feature of a window (website) that resulted from a prior search (selecting a tab); yet giving that Moran discloses such a feature in the reference would be the motivation and would be obvious.

- b. Applicant argues that the combinations of Moran and Kessenich lack the teachings of the search refining. The Examiner however disagrees. Kessenich discloses refining search results (Col 13, Lines 29-33).

Points of Contact

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haythim J. Alaubaidi whose telephone number is (703) 305-1950 and starting October 18 2004 the telephone number will change to (571) 272-4014. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.


Any response to this office action should be mailed to:

The Commissioner of Patents and Trademarks, Washington, D.C. 20231 or telefax at our fax number (703) 872-9306.

Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, 6th Floor Receptionist, Arlington, Virginia. 22202.

Haythim J. Alaubaidi

Patent Examiner
Technology Center 2100
September 1, 2004


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100